



AF/1616 # IZw

PATENT
Customer No. 22,852
Attorney Docket No. 05725.0470-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
Jean-Michel STURLA et al.) Group Art Unit: 1616
Application No.: 09/385,412) Examiner: Marina Lamm
Filed: August 30, 1999)
For: AEROSOL DEVICE CONTAINING A) Confirmation No.: 9112
POLYCONDENSATE COMPRISING)
AT LEAST ONE POLYURETHANE)
AND/OR POLYUREA UNIT)

Mail Stop Appeal Brief--Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 1.193

Pursuant to 37 C.F.R. § 1.193, Appellants present, in triplicate, the Reply to the Examiner's Answer dated June 15, 2004, and an accompanying Request for Oral Hearing.

If any fees are required in connection with the filing of this paper that are not filed herewith, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

REMARKS

In response to Appellants' Brief filed April 6, 2004, the Examiner maintains her position that the presently claimed invention is *prima facie* obvious over U.S. Patent No. 5,643,581 to Mougin et al. ("Mougin") in view of U.S. Patent No. 5,125,546 to Dunne et al. ("Dunne"). See Examiner's Answer dated June 15, 2004. Appellants respectfully continue to disagree for the reasons of record and the additional reasons presented below.

I. **Response to Examiner's Answer**

The Examiner continues to assert that "the multiblock polycondensates of Mougin et al. appear to be identical to those claimed in the instant claims." Examiner's Answer at page 4, lines 8-9. Appellants, however, disagree, as the Examiner's statement continues to disregard relevant teachings of the cited references, thereby distorting what would otherwise be "fairly suggested" to one of ordinary skill in the art. See *In re Burckel*, 592 F.2d 1175, 1179, 201 U.S.P.Q. 67, 70 (C.C.P.A. 1979) ("[A] reference must be considered not only for what it expressly teaches, but also what it fairly suggests.").

The continued indifference shown for the express teachings of the cited references in hopes of creating Appellants' invention contravenes the statutory mandate of Section 103. In particular, a *prima facie* case of obviousness cannot be established, *inter alia*, without a showing that the combined references teach or suggest all the claimed limitations. M.P.E.P. § 2143 (8th ed. Rev. 2, 2004).

For example, neither Mougin nor Dunne teach or suggest that “wherein said at least one polycondensate is formed by an arrangement of blocks, this arrangement being obtained from: (1) at least one compound which contains at least two active hydrogen atoms per molecule; (2) at least one diol containing at least one functional group chosen from acid radicals and salts thereof; and (3) at least one isocyanate chosen from di- and polyisocyanates.” See, e.g., Claim 1. In response to this argument, the Examiner states that with regard to (2) the at least one diol containing at least one functional group chosen from acid radicals and salts thereof, “there appears to be no criticality associated with the above mentioned diol . . . because the acid will be consumed in the process of making polyurethane,” and that without a recitation ensuring excess acid in the resulting polycondensate, Mougin meets the claim limitations of Appellants’ invention. Examiner’s Answer at page 4, lines 12-18.

In particular, Section 103 and the Federal Circuit make it clear that the test for obviousness is not whether the *resulting product* contains a particular element recited in the claim, as asserted by the Examiner, but whether a skilled artisan, confronted with the same problems, would select the particular elements individually disclosed in the references and combine those elements to yield the claimed invention. *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). In this instance, the Examiner fails to indicate nor do the cited references provide the arrangement and/or elements as claimed, i.e., wherein the polycondensate is formed by an arrangement of blocks from, among other things, the at least one diol containing at least one functional group chosen from acid radicals and salts thereof.

Instead, Mougin teaches that its polycondensate is prepared in a two-stage process. Mougin at Col. 3, lines 8-10. The first stage involves reacting (i) a polysiloxane and (ii) a diisocyanate whereby a new silicone is obtained. *Id.* at Col. 3, lines 10-17. In the second stage, the chains of the polycondensate obtained are coupled by means of a coupling agent chosen from diols and/or diamines and/or alcoholamines. *Id.* at Col. 3, lines 18-24. As asserted in Appellants' Appeal Brief, Mougin fails to identify or provide any guidelines with respect to the coupling agent in Col. 4, lines 17-27 that results in an element of Appellants' claimed invention, i.e., a diol containing at least one functional group chosen from acid radicals and salts thereof. See Appellants' Appeal Brief at pages 7-8.

Rather, Mougin's disclosure regarding the coupling agents merely provides for endless possibilities that do not amount to a suggestion or motivation to render obvious Appellants' recited claims. See *In re Baird*, 16 F.3d 380, 382, 29 U.S.P.Q.2d 1550, 1552 (Fed. Cir. 1994) (finding no suggestion in the prior art's generic formula to select a particular combination of variables that would result in the claimed invention and as such, did not render obvious the claimed invention).

Similarly, the secondary reference, Dunne, does not teach the inclusion of this element. Instead, Dunne is cited to teach the inclusion of a cosmetic composition in an aerosol container. Examiner's Answer at page 3. As such, the combination with Dunne does not remedy the deficiencies of Mougin.

II. Conclusion

For the reasons of record and the reasons set forth above, Appellants maintain that a prima facie case of obviousness has not been established by the Examiner based on the combination of the cited references. The Examiner fails to demonstrate that the cited references teach or suggest all the claim limitations. Appellants maintain this position with respect to all issues covered by the Appeal Brief filed on April 6, 2004. Accordingly, Appellants respectfully request reversal of the rejection of claims 1 - 29 under 35 U.S.C. § 103(a).

To the extent any further extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, please charge such fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: August 13, 2004

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